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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,604	04/16/2004	Aaron Hobart	55616.107558	1194
27526 7590 08/22/2008 HUSCH BLACKWELL SANDERS LLP 4801 Main Street Suite 1000 KANSAS CITY, MO 64112				
EXAMINER				
AFTERGUT, JEFF H				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/826,604

Applicant(s)

HOBART, AARON

Examiner

Jeff H. Aftergut

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 8-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 18-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Election/Restrictions

1. Claims 8-17 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 7, 2006.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 18-20 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Niskanen for the same reasons as expressed in paragraph 2 of the Office action dated June 5, 2007.
4. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 3 further taken with Fujiwara for the same reasons as expressed in paragraph 3 of the Office action dated June 5, 2007.
5. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 4 further taken with Gangemi for the same reasons as expressed in the Office action dated June 5, 2007, paragraph 4 therein.
6. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 3 further taken

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with Rodriguez for the same reasons as expressed in paragraph 5 of the Office action dated June 5, 2007.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 4 further taken with Rodriguez for the same reasons as expressed in paragraph 6 of the Office action dated June 5, 2007.

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 5 further taken with Rodriguez for the same reasons as expressed in paragraph 7 of the Office action dated June 5, 2007.

9. Claims 1-3, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Niskanen and any one of Butterworth et al (US 2002/0170649) or Butterworth et al (US 6,372,064) for the same reasons as expressed in paragraph 8 of the Office action dated April 10, 2008.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 9 further taken with Fukiwara for the same reasons as expressed in paragraph 9 of the Office action dated April 10, 2008.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 10 further taken with Gangemi for the same reasons as expressed in paragraph 10 of the Office action dated April 10, 2008.

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12. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 9 further taken with Rodriguez for the same reasons as expressed in paragraph 11 of the Office action dated April 10, 2008.

13. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 10 further taken with Rodriguez for the same reasons as expressed in paragraph 12 of the Office action dated April 10, 2008.

14. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 11 further taken with Rodriguez for the same reasons as expressed in paragraph 13 of the Office action dated April 10, 2008.

Response to Arguments

15. Applicant's arguments filed July 10, 2008 have been fully considered but they are not persuasive.

At the outset, it should be noted that while applicant argues that the Examiner posit as to what the field of endeavor is related to is "inapposite because Applicant did not present arguments directed to the field of endeavor but rather addressed the failings of the APA in teaching or suggesting Applicant's claimed apparatus", the applicant is advised that the discussions relating to the field of endeavor is highly appropriate as it establishes what prior art is relevant for one to consider in the determination of obviousness under 35 USC 103(a). The applicant goes to great length to explain what a person of ordinary skill in the

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field of endeavor is and what is required of a prima facie case. The applicant is advised that one skilled in the art would have determined that the reference to Niskanen was relevant to the question of whether one skilled in the art would have employed an automated means to secure the leading edge of the membrane to the core where adhesive was applied to the core or secure the tail to the wound material with adhesive application to the web of material being wound up. The applicant does not dispute the reasons expressed by the Office as to why one skilled in the art would have been motivated to look to the teachings of Niskanen and applied the same to the admitted prior art in order to reduce the number of operators needed in the winding operation and increase efficiency and productivity in the same. The applicant notes that the teaching or suggestion must be supplied by the references themselves, however this argument has not been found to be persuasive. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references, Ex parte Clapp, 227 USPQ 972, 973. Here, one skilled in the art would have been motivated to provide the adhesive dispensing device to apply adhesive in the wind up of the membrane material for the reasons presented in the Office action, let alone the express teaching in Niskanen which states that in reeling machines there was a long felt need to provide a means to apply glue to fix the end (leading edge) of web to the core when a new web was introduced

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without exposing the remainder of the equipment used in the winding operation to the glue which caused problems during operation (column 1, lines 15-22).

Clearly, one skilled in the art would have been motivated to provide the specified adhesive application means suggested by Niskanen in the system of the admitted prior art.

Applicant is also advised regarding the "long felt need" arguments, that the issue of analogous art is additionally relevant to the same. While as evidenced by the prior art of record, no individual alone knew of the necessity to provide the specified claimed system in the take up of a membrane, the necessity to provide fast and effective systems for take up of indeterminate length materials clearly was aware of the need for an automated system which included an adhesive dispensing device as evidenced by Niskanen. Note that because the field of endeavor is not so overly limited just to the take up of a membrane (but rather is more generally directed to the take up of indefinite length materials in a wind up (roll) form) one cannot assert the lack of solution to a problem of "long felt need" for a roofing membrane was not present in the prior art. To the contrary, the "long felt need" was satisfied by systems like that of Niskanen which would have been useful in the system for taking up a roofing membrane (as it is directed to the take up of an indefinite length material). To say that the determination of the field of endeavor and the relevance of whether a reference is analogous art of not is not relevant to "long felt need" as well as "suggestion/reason/motivation" for making a combination is incorrect and applicant's argument in this regard has not been found to be persuasive.

Applicant provides an analysis of the claims as it relates to claims 1 and 18. The applicant's analysis of claim 1 is correct. And the analysis of the prior art relative to claim 1 (and the application of the adhesive to the upper portion of the core) will be discussed at length below. In addressing the reference to Niskanen the applicant argues that claim 18 "is directed to applying an adhesive to the width of the membrane for affixing the leading edge to the core not the "tail" as stated by the Examiner", however a closer examination of claim 18 indicates that the adhesive applicator "is configured for traversing at least a portion of the length of the core parallel to the axis thereof to apply an adhesive material to the width of the membrane" (note that there is no mention of application of the adhesive to the "leading edge" of the membrane as argued by applicant. Additionally, while the guide is provided for indexing the leading edge of the membrane upon the core, there is no nexus in the claim as presented which indicates that the leading edge of the membrane bears an adhesive thereon when it is indexed to the core. As such, applicant's analysis of claim 18 is not commensurate in scope with the claim. The claim DOES NOT require application of the adhesive upon the leading edge of the membrane but rather merely requires adhesive application to the width of the membrane which was suggested by Niskanen with the application of adhesive across the width of the web top secure the end of the web to the wound material, column 3, lines 21-25.

Regarding the arguments presented regarding the reference to Niskanen, the applicant essentially makes the following two arguments: (1) the reference did not teach or suggest that those skilled in the art would have applied the

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adhesive upon the core on the upper surface of the core (and application of adhesive to the upper surface of the core would have materially destroyed the operation of Niskanen), and (2) there is simply no way to bodily incorporate the system of Niskanen in the admitted prior art and one skilled in the art would not have known how to do the same. These arguments have not been found to be persuasive. First regarding the lack of a teaching regarding the application of the adhesive to the upper surface of the core where the application means traversed the width of the core element, the applicant is initially advised that this argument is only relevant as it relates to claim 1 (as claim 18 relates to the application of adhesive upon the membrane rather than the core). The reference to Niskanen clearly provided an adhesive applicator head 12 which was disposed at the end of body part 11. The body part 11 was provided with rollers 14 which ride in rails 16 in a stationary slide member 15. As such, the adhesive head 12 traversed the core and the width of the membrane from one longitudinal side to the other, see arrow A of Figure 2. The reference to Niskanen clearly provided an adhesive dispenser which traversed the width of the web (or membrane). The reference did, as admitted in the Office action, suggest application of the adhesive upon the lower surface of the core rather than the upper surface of the core as depicted in Figure 1. However, applicant is advised that one cannot show unobviousness by attacking references individually where combinations of references have been applied against the claimed invention. Here, as it pertains to claim 1, the references to Butterworth '064 and '649 were applied against the claim in the prima facie case. There is no indication of unexpected results relating to the

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application of the adhesive on the upper surface of the core as opposed to the underside of the core and the references to either one of Butterworth '064 or '649 clearly expressed that application of the adhesive on the upper surface of the core or the underside of the same. See the Office action dated April 10, 2008 and note that the adhesive sprays of Butterworth were able to direct the adhesive from various locations and onto either the tail or the cores themselves. Where, as here, two equivalents were known for the same function, an express suggestion of the desirability of the substitution of one for the other is not needed to render such substitution obvious, In re Fout, 213 USPQ 532, In re Siebentritt, 152 USPQ 618. Clearly, application of the adhesive from a nozzle disposed above the core to apply the adhesive to the upper surface thereon would have been obvious to those having ordinary skill in the art. Additionally in this regard, applicant is advised that those skilled in the art would have understood how to modify the admitted prior art to provide the same with an adhesive dispensing mechanism which traversed the length of the core or the width of the membrane as the courts have repeatedly found that those skilled in the art having been taught the desirability of certain modifications, would recognize that other modifications were needed to accommodate the modification, and that one skilled in the art would have been expected to have sufficient basic knowledge to construct such means, the structure of which appears to be simple, In re Bode et al, 193 USPQ 12. Here, one is not destroying the admitted prior art or Niskanen at all but rather making modifications to provide a dispensing mechanism above the core which modifications would have been attainable by those skills in the art. One skilled in

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the art would have known how to make the modifications necessary to provide for the application of adhesive upon the upper surface of the core in the manner proposed and no undue experimentation would be required to make such modifications. In fact, one would have reasonably been expected to achieve success in modifying the admitted prior art in the manner proposed in order to apply adhesive to the core or to the membrane across the width of the same. It should be noted that the principals of operation of Niskanen would not be completely changed in making the modifications outlined as the principal of operation in Niskanen was to provide adhesive upon the core or the web in a manner which did not contaminate the other components of the system and doing so at the take up roll or adjacent the same would not have contaminated the rest of the components of the system with adhesive nor would it have effected the take up of the material upstream of the take up roller.

Regarding whether the reference to Niskanen taught the application of adhesive across the width of the membrane as it relates to claim 18, as discussed above, claim 18 does not require application of adhesive to the leading edge of the membrane as argued by applicant. Additionally, note that Niskanen as discussed above provided means for applying a bead of adhesive across the web of material to traverse the entire width of the web as depicted in Figures 1 and 2 and as indicated by the movement with arrow A.

Applicant argues that the references to Fujiwara, Gangemi, Rodriguez or either one of Butterworth '064 or '649 made up for the deficiencies of the combination of the admitted prior art and Niskanen, however, no such

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deficiencies are present as addressed above. It should be noted that applicant does not dispute the teachings of these references for which they were applied in the Office action. The applicant notes that there is no reason provided for using the teachings of these references (in a generic, blanket statement without addressing any of the reasoning presented in the previous actions) in combination with the admitted prior art and Niskanen (rather than addressing the specific teachings of these references). However as expressed in the Office action dated June 5, 2007, one would have understood that the web material was severed as some point in the wind up operation (of the admitted prior art and Niskanen) in order to provide a new leading end as well as a tail for the membrane and a suitable known construction of the cutting mechanism was suggested by Fujiwara as one must sever the web at some point and performing the same adjacent the take up with the mechanism of Fujiwara would have been prima facie obvious. Regarding Gangemi, note that both Fujiwara and Niskanen provided mechanisms which traversed the web (were moved across the web) wherein one employed a traversing cutter and the other employed a traversing adhesive dispenser. Neither suggested mounting both upon the same traversing mechanism. In order to reduce the number of traversing arms employed, it would have been obvious to provide both an adhesive dispensing mechanism as well as a cutting mechanism on a traversing mechanism as suggested was known by Gangemi (providing such a single traversing means with both the adhesive dispenser and the cutting knife thereon would have simplified the system). One skilled in the art would have additionally been expected to employ a computer

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control (a controller) to control the mechanical means disclosed in the references as such would have eliminated the need for manual interface in the operation as suggested by Rodriguez. It should be noted that while none of Fujiwara, Gangemi, or Rodriguez taught a take up system for a membrane, they all related to the take up and wind up of indeterminate length web materials which as previously discussed is the field of endeavor with which applicant's invention pertains. Regarding Butterworth '064 or '649, note that the reason for using the teachings of these references was previously identified and discussed as the use of a functionally equivalent alternate expedient which does not require express teaching, suggestion or motivation.

No claims are allowed.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Aftergut whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:30-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeff H. Aftergut/
Primary Examiner
Art Unit 1791

JHA
August 19, 2008